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REMARKS

In the Final Office action mailed on November 3, 2006 ("the Final Action"), the Examiner considered claims 10-28. Claims 10-28 have been rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. Claims 10-28 have been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,405,177 ("DiMattina"). The Examiner has withdrawn the rejection of claims 1-9 under 35 U.S.C. § 101.

Applicant respectfully submits the present Amendment and Response, in which claims 10-19 and 21-28 have been amended to further clarify the subject matter claimed. Applicant respectfully submits that no new matter has been introduced by the present Amendment and Response. Support for this amendment can be found in, for example, the Abstract, the Figure, and paragraph numbers [0040]-[0108] of the present application.

In view of the amendments to the claims together with the following remarks, Applicant respectfully requests reconsideration and withdrawal of all grounds of rejection.

Withdrawn Claim Rejections

In the Final Action, the Examiner withdrew the previous rejection of claims 1-9 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant would like to thank Examiner for withdrawal of this ground of rejection.

Claim Rejections

Rejection of Claims 10-28 under 35 U.S.C. § 112, ¶ 1

Claims 10-28 stand rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. Applicant respectfully traverses.

For a rejection under 35 U.S.C. § 112, ¶ 1 for lack of enablement to be proper, an Office Action must demonstrate that one reasonably skilled in the art would not be able to make or use the invention from the disclosures in the patent application coupled with information known in the relevant art without undue experimentation. To establish a reasonable basis for questioning the adequacy of a disclosure, the Office Action must present a factual analysis of the patent application to show that a person of skill in the art would not be able to make and use the

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claimed invention without resorting to undue experimentation. MPEP § 2164.06(c). Specifically, “[i]n computer applications, it is not unusual for the claimed invention to involve two areas of prior art or more than one technology, e.g., an appropriately programmed computer and an area of application of said computer.” *Id.* In such cases, the knowledge of persons skilled in both technologies is the appropriate standard for determining the sufficiency of the disclosure for enablement purposes. *Id.*

Applicant’s claims are directed to providing insurance coverage and reducing liability associated with a plurality of business activities or transactions conducted on the internet. As such, Applicant respectfully submits that one of skill in the computer programming and/or insurance arts would understand that the use of a computerized method and system (including computer program) to provide such coverage or reduce such liabilities is inherent in Applicant’s specification and is present throughout the application, even without explicit mention. Similarly, one of skill in the computer programming and/or insurance arts could, without undue experimentation, make or use a computerized method for mitigating internet-related risk and reducing a customer’s potential liability for conducting business on the internet as recited by claims 21-24. Applicants also submit that one of skill in the computer programming and/or insurance arts could, without undue experimentation, make or use a computer program and system for storing and retrieving digital data from a digital memory as recited by claims 25-28. Additional evidence to support the level of skill in the relevant computer programming and/or insurance arts can be found by reference to the Information Disclosure Statements submitted to the U.S. Patent and Trademark Office on May 28, 2002, April 9, 2003, June 30, 2005, and July 13, 2006, and by reference to the references cited therewith.

By way of example, the Figure and the description of the various insurance coverages described in paragraphs [0040]-[0108] describe in detail features and different types of insurance coverages relating to reducing a customer’s liability for a plurality of business activities or transactions conducted on the internet via a customer interface, for example, as illustrated in the product “suite” shown in the Figure. Applicant respectfully submits that one of ordinary skill in

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the computer programming and/or insurance arts would know how to make or use Applicant's invention without undue experimentation based on these descriptions of Applicant's invention.

As a further example, the specification describes the AIGnetAdvantage Professionals™ policy in paragraphs [0053]-[0064] and includes several features of the policy such as the definition of acts covered (paragraph [0057]), the definition of "claims" (paragraph [0059]), claim settlement (paragraph [0062]), and policy limits (paragraph [0064]). Applicant submits that based on at least these detailed descriptions, one of skill in the computer programming and/or insurance arts could, without undue experimentation, make or use a computerized method for providing such insurance coverages as recited by claims 10-20. For example, Applicant submits that one of skill in the insurance arts could, based on inputs such as the policy limits, definition of acts covered, and definition of claims, in view of the "suite" of insurance products shown in the Figure, practice the method of claim 10 of offering a plurality of insurance coverages to a customer, providing a price quote for the insurance coverages based on a selection of coverages by the customer, and providing an insurance policy to the customer in response to the customer accepting the price quote as recited in claim 10 without undue experimentation.

The Final Action states that Applicant's claims newly added claims are unsupported by the specification, which was filed September 18, 2001. However, Applicant respectfully submits that the proper test is not whether there is literal support in the specification for Applicant's amendments, but rather, whether one of ordinary skill in the art could make and use Applicant's claimed invention without undue experimentation. "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability of the art...The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification." § MPEP 2164.03. A patent application need not teach, and preferably omits, what is well known in the art.

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Because Applicant's description in the specification of the claimed features are sufficient to enable one of ordinary skill in the computer programming and/or insurance arts to make or use the claimed invention, Applicant respectfully requests withdrawal of this ground of rejection.

Rejection of Claims 10-28 under 35 U.S.C. § 102(e)

Claims 10-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by DiMattina. Applicant respectfully traverses.

For a rejection under 35 U.S.C. § 102(e) to be proper, a single reference must teach or describe all of the elements as arranged in Applicant's claims. Applicant respectfully submits that DiMattina fails to teach or suggest at least one element of Applicant's claims as amended. For example, DiMattina, fails to teach or suggest at least "offering, by an insurer, to a customer a plurality of insurance coverages to cover a plurality of the customer's activities conducted on the internet" as recited by Applicant's claim 10 as amended. Independent claims 21, 22, 23, 25, and 27 have been similarly amended to recite "a plurality of insurance coverages" offered to a customer to reduce a liability associated with "a plurality of transactions/business activities conducted over the internet." Furthermore, DiMattina fails to teach or suggest providing insurance in a two-party transaction, between an insurer and a customer as recited by Applicant's claims as amended.

DiMattina describes a way to secure commercial transactions on-line. More specifically, a customer who wishes to make a purchase online from an electronic retailer (an "e-tailer") is given a choice to "secure" the transaction by purchasing, for an additional price and from a third-party insurer/guarantee provider, insurance that contains certain guarantees in connection with the online purchase. See col. 3, line 48 - col. 4, line 21; col. 5, lines 23-31. The third-party insurer/guarantee provider is not a party to the underlying electronic retail transaction, and the insurance purchased by the customer in the system of DiMattina reduces potential loss to the customer associated with the online purchase. For example, the insurance covers the customer's loss by covering nongenuine goods or covering losses to the consumer of stolen identity information. Unlike Applicant's claimed invention, the system of DiMattina involves a

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commercial transaction requiring three entities, the seller (or e-tailer), the customer, and the insurer. The insurer appears to be involved only in the specific transaction between the e-tailer and the customer. The e-tailer sells goods or services to the customer, and the insurer offers for sale insurance to be purchased from a third party where the insurance is associated only with the particular goods or services to be sold to the customer in that transaction. Thus, the guarantee provider only offers the guarantee in connection with a particular transaction. The guarantee provider does not provide insurance to cover a plurality of the customer's (or e-tailer's) transactions or business activities conducted online.

Conversely, Applicant's claims are directed to a two-entity transaction directly between an insurance provider (an insurer) and an insurance purchaser (an insured or customer) in a particular transaction. More specifically, the insurer according to Applicant's claims offers a variety of insurance coverages that may be independent of a particular transaction between the insured (e.g., an e-tailer) and a third party (e.g., an end customer). The insurance coverages offered by the insurer cover a plurality of business transactions conducted online. For example, a single insurance policy offered by the insurer covers multiple instances of publication of web content, where any of the instances may give rise to a libel action. Conversely, if used analogously to Applicant's invention, the system of DiMattina appears to require that a customer purchase a new insurance policy for each instance of online publication. This in contrast to Applicant's system and method, in which the insured (customer) is able to purchase the insurance policy independently of any other transaction and potentially covering all of the insured's (customer's) activities conducted on the Internet.

Consequently, unlike the system of DiMattina, Applicant's claims are directed to a situation in which the price of the insurance policy is not added as an itemized cost to an already-established price for the sale of the e-tailer's goods or services associated with a particular transaction. Thus, according to Applicant's claims, for example, an e-tailer can purchase an insurance coverage selected from a plurality of insurance coverages from the insurer to cover all of the e-tailer's business conducted online (e.g., a plurality of transactions covered under a single

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policy). Examples of the types of business activities covered under a single policy as recited in Applicants include insurance to protect against liability resulting from advertising or marketing business conducted on the Internet, professional services rendered via the Internet, third party liability for business conducted on the Internet, or network security when conducting business on the Internet.

Finally, the Final Action states:

[r]egarding the remaining features of claims 10-28, as per the recitation of various risks and associated coverages to be offered...the differences between the applied prior art are only found in the nonfunctional data material (i.e., the type of data/coverage specified) and are not functionally involved in the steps recited. The steps of providing different coverages or coverage options would be performed the same regardless of the data/types of coverage offered. The descriptive material does not alter the method steps or functionality of the method steps as currently claimed. Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability...common situations involving nonfunctional descriptive material are: 'a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.'

Applicant respectfully disagrees that the types of insurance coverage or the types of business transactions covered are simply non-functional descriptive material that do not influence how the process steps are performed. By way of example, at least the step of providing a price quote for a set of insurance coverages, as recited by Applicant's independent claims, is performed differently based on the type of insurance coverages selected. This is because the insurance coverages selected generally cover a plurality of business activities or transactions conducted on the internet. The price quote can vary depending on various features of the particular set of insurance coverages selected. For example, the price quote calculated when a customer selects the AIGnetAdvantagesSM coverage (paragraph [0043]) can be based on the policy limits (paragraph [0052]) as well as the number and type of transactions covered (paragraph [0044]). An online provider of subscription content consisting of political

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commentary updated daily may require a higher coverage amount and thus a higher price quote than a quarterly on-line newsletter published by a non-profit organization.

As different types of insurance coverages are selected, the number of factors that influences or changes the price quote similarly increases. Using the above example, if a customer were to also select AIGnetAdvantage ProfessionalsTM coverage (paragraph [0053]), the nature and frequency of the professional services offered could be used as additional inputs to calculate the price quote for the combined AIGnetAdvantagesSM and AIGnetAdvantage ProfessionalsTM coverages in addition to the factors considered in providing only a single coverage. Because the type of insurance coverage selected and the nature of the plurality of business transactions or online activities affects at least the provision of a price quote, Applicant respectfully submits that the data and type of coverage is not merely non-functional or descriptive. Applicant respectfully requests withdrawal of this basis for rejection.

Applicant notes that the Final Action cites the same passages from DiMattina to support the rejection of all of Applicant's pending claims with the exception of the rejection of claim 20. Particularly, the Office Action cites the Abstract, col. 2, lines 1-16 and lines 50-67, col. 3, lines 1-30 and lines 56-67, and col. 4 lines 1-54 to support the rejections of claims 10-19 and 21-28 without indicating how Applicant's claims are interpreted or anticipated by those sections of DiMattina. If this ground of rejection is not withdrawn, Applicant respectfully requests the Examiner to point out which features of DiMattina are deemed to teach or suggest Applicant's claimed features by quoting verbatim language from DiMattina believed to support the rejection and the construction of Applicant's claims used by the Examiner. As shown above, the types of business transactions covered by Applicant's invention are not merely descriptive or non-functional, and Applicant requests the Examiner to point to specific passages in DiMattina believed to anticipate each type of insurance coverage and plurality of transactions recited in Applicant's dependent claims 11-18, 24, 26, and 28.

For at least the reasons discussed above, Applicant respectfully submits DiMattina does not teach or suggest every limitation recited by Applicant's independent claims 10, 21, 22, 23,

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25, and 27. Therefore, Applicant respectfully submits that claims 10, 21, 22, 23, 25, and 27 are allowable. Claims 11-20, 24, 26, and 28 depend from Applicant's independent claims, and Applicant submits that these claims also recite patentable subject matter for at least the same reasons. Accordingly, Applicant respectfully requests withdrawal of all remaining grounds of rejection. Favorable consideration of the claims is respectfully requested.

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CONCLUSION


Applicants respectfully submit that the claims 10-28 are in condition for allowance and request a notice to that effect. The Examiner is invited to contact Applicant's attorney at the number below if the Examiner believes such a call would put the claims further expedite the examination and allowance of the application.

The Commissioner is hereby authorized to charge any fee occasioned by the entry of this paper to Attorney's Deposit Account No. 50-3081.

Respectfully submitted,

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